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OFFICE OF PETITIONS

In re Patent No. 7,481,805	:	DECISION ON REQUEST FOR
Anders Magnusson	:	RECONSIDERATION OF
Issue Date: January 27, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/606,538	:	AND NOTICE OF INTENT TO
Filed: June 26, 2003	:	ISSUE CERTIFICATE OF
Docket No. 12389-004001/	:	CORRECTION
PD53566USO	:	

This is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT", filed January 8, 2009, requesting that the determination of patent term adjustment be reviewed for accuracy pursuant to a duty of candor. This is also in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed March 27, 2009, requesting that the determination of patent term adjustment be corrected from three hundred seventy-six (376) days to six hundred thirty-three (633) days.

The request for reconsideration of patent term adjustment is GRANTED to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised patent term adjustment of two hundred eighty-three (283) days.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

On January 27, 2009, the above-identified application matured into U.S. Patent No. 7,481,805 with a revised patent term

adjustment of 376 days. This request for reconsideration of patent term adjustment was timely filed.

Initially, patentees disclose that they should have been assessed a period of delay of 93 days, pursuant to 37 CFR 1.704(c)(7), for the filing of a reply having an omission on January 23, 2006.

Pursuant to 37 CFR 1.704(c)(7), the submission of a reply having an omission (§ 1.135(c)) is a failure to engage in reasonable efforts to conclude prosecution, and the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

It is undisputed that the reply of January 23, 2006, contained an omission and that a reply correcting the omission was not filed until April 26, 2006. Thus, the period of reduction pursuant to 37 CFR 1.704(c)(7) is 93 days, counting the number of days beginning on January 24, 2006, the day after the first reply containing an omission was filed, and ending on April 26, 2006, the date the omission was corrected. Accordingly, a period of reduction of 93 days will be entered.

Further, patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees contend that the correct number of days of patent term adjustment is 633 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees asserts that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that the total non-overlapping PTO delay under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) is 789 (439 + 350) days as these periods do not occur on the same day. Further, given the applicant delay of 156 days, patentee asserts entitlement to 633 (789 - 156) days of patent term adjustment.

Patentees' interpretation of the period of overlap has been considered, but has been found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A).

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*¹ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final*

¹ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date of the filing of the application under 35 U.S.C. 111(a) on June 26, 2003, and ending on the date of filing of the first request for continued examination (RCE) on June 11, 2007 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE.² 35 U.S.C. 154(b)(1)(B)(i).

² As of the filing of the RCE on June 11, 2007, the application was pending three years and 350 days.

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1),³ 439 days⁴ of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. There were no Office delays subsequent to the filing of the request for continued examination. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 350 days of patent term adjustment accrued for Office issuance of the patent more than three years after the filing date of the application.

All of the 350 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 439 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 439 days and the 350 days is neither permitted nor warranted. 439 days is the actual number of days issuance of the patent was delayed. Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment, having considered the 350 days of Office delay under the three-year pendency provision.

In view of the additional period of reduction pursuant to 37 CFR 1.702(c)(7), the patent term adjustments indicated on the patent should be 283 days (439 days of Office delay - 156 days of applicant delay).

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

³ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

⁴ A Restriction Requirement was mailed on November 8, 2005, fourteen months and 439 days after the filing of the application on June 26, 2003.

This application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 283 days.

Telephone inquiries specific to this matter should be directed the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,481,805 B2

DATED : Jan. 27, 2009

INVENTOR(S) : Magnusson

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (376) days

Delete the phrase "by 376 days" and insert – by 283 days--